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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,674	02/04/2004	Marc Ira Lipton	8285/671	5600

7590 01/26/2007
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EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/772,674	LIPTON ET AL.	
	Examiner	Art Unit	
	Simon Sing	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 34-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 34-57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,041,104 ('104 hereafter) respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other. Because claims in this continuation are broader than the ones in the patent, in the *re Van Ornum and Stang*, 214 USPQ 761, broad claims in continuation application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 34 of the present invention is

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the same as claim 10 of the patent except omitting the telephone network, the storage medium and the transmitter of claim 10. Therefore, claim 34 of the present invention is broader than claim 10 of '104. Claim 46 of current invention is also broader than claim 1 of '104.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 34-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. US 5,819,029 in view of O'Neal et al. US 5,887,253.

2.1 Regarding claims 34 and 46, Edwards discloses a third party verification system in figure 1, comprising:

a receiver (a telephone interface in the system controller 112) associated with a third party verification (TPV) service to receive, during a telecommunication call, a reply message to confirm an authorized switching to a new long distance service (a telephone service contract inherently is a term and condition contract), or credit and loan processing services (terms and condition contract) (column 9, line 41 to column 10, line 63; column 12, lines 59-67);

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a processor (system controller 112) in communication with the receiver;
a database (IVR response repository 114) in communication with the processor;
and

wherein the processor creates a record in the database, including audio recordings of affirmative acceptance of the long distance service (column 13, line 66 to column 14, line 23; column 15, lines 27-61).

Edwards teaches verifying a contract with a long distance service provider with various voice prompts (column 12, lines 64-66; column 13, lines 57-67; column 14, lines 23), but is silent on the terms and conditions of the contract.

However, it was well known in the art that a contract was associated with terms and conditions, and O'Neal teaches a voice response unit (VRU) for playing a pre-recorded voice message (prompt) concerning terms and conditions of a cellular service (contract) and other contract provisions to a customer, and recording responses from the customer (column 13, lines 19-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Edwards' reference with the teaching of O'Neal, so that the voice prompts of Edwards would have included terms and condition of the long distance service contract, because such a modification would have provided proof that a customer understood and approved the terms of a new service contract.

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2.2 Regarding claim 35, Edwards teaches that a spoken reply message indicates an acceptance of a telephone service (column 10, lines 43-55, 61-63; column 12, lines 64-67).

2.3 Regarding claims 36 and 47, Edwards teaches recording a subscriber's identity information (column 14, lines 1-2).

2.4 Regarding claim 37, Edwards teaches indicating a service provide identity (column 10, lines 49-51; column 12, lines 64-67).

2.5 Regarding claim 38, Edwards teaches timing information of a call (column 6, lines 44-46).

2.6 Regarding claim 39, Edwards teaches the identity of a calling party (telemarketer) (column 10, lines 11-15).

2.7 Regarding claims 40 and 48, Edwards teaches recording a customer's responses to verification prompts (column 10, lines 61-64).

2.8 Regarding claims 41, 49 and 50, it is inherent that by law, a service provider is required to mail a customer a printed copy of terms and conditions of a service contract (see US 3,999,700, column 3, lines 28-33).

2.9 Regarding claims 42 and 51, Edwards teaches a verbal service message (column 10, lines 49-51; column 12, lines 64-67).

2.10 Regarding claims 43 and 52, Edwards teaches a long distance telephone service (column 10, lines 49-51; column 12, lines 64-67).

2.11 regarding claims 44 and 53, Edwards teaches a voice call initiated by telemarketer (column 9, lines 41-51).

2.12 Regarding claim 45, Edwards teaches conferencing a telemarketer with the verification process, and in that the telemarketer may speak to the customer on intervene at any time (column 10, lines 24-28).

2.13 Regarding claims 54-57, Edwards teaches prompting a customer to say 'yes' or 'no' to a long distance telephone service (column 12, lines 64-67).

Response to Arguments

3. Applicant's arguments with respect to claims 34-57 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Walker et al. (US 5,794,207) discloses a method and system of a telemarketing service, including terms and conditions (column 1, lines 14-25, 66-67; column 2, lines 1-6; column 4, lines 13-27; column 20, lines 31-48).

b) Megyesi (US 5,544,230) discloses a method and system for recording a telemarketing sale presentation (Abstract).

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

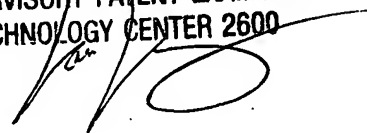
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A handwritten signature in black ink, consisting of a series of loops and a horizontal line.

S. Sing

01/16/2007

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, featuring a large, stylized 'F' and 'T'.